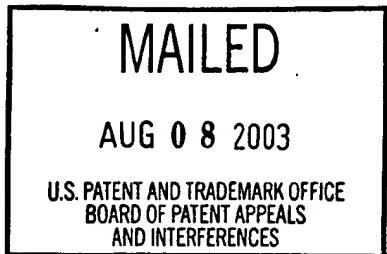


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**



Ex parte ANDREA F. BELL

Appeal No. 2003-1271
Application No. 08/901,713

ON BRIEF

Before ABRAMS, NASE, and BAHR, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 31, which are all of the claims pending in this application.

We REVERSE and REMAND.

BACKGROUND

The appellant's invention relates to utility aprons useful for retaining various items such as cleaning items (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Baumgartner	3,678,977	July 25, 1972
Lindsay	4,993,551	Feb. 19, 1991
Yoo	5,431,265	July 11, 1995

Claims 1 to 31 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lindsay in view of Baumgartner.

Claims 1 to 31 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lindsay in view of Baumgartner and Yoo.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 26, mailed March 6, 2002) and the answer (Paper No. 32, mailed December 20, 2002) for the examiner's complete reasoning in support of the rejections,

and to the brief (Paper No. 30, filed October 9, 2002) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 31 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

With this as background, we analyze the prior art applied by the examiner in the rejection of the claims on appeal.

Lindsay's invention relates to a tool holder and storage device which interfits and hangs over the rim of a bucket equipped with a handle. In Figures 1 and 2, a tool holder device 10 is shown draped over and supported by a five gallon, non-tapered bucket 12 which can be any common bucket typically available to the craftsman and for home use. Handle 14 extends across the opening and downwardly over the outside surface of the bucket to median area position 18 on the outside surface of the bucket where lower ends 16 of handle 14 engage in and attach to the bucket side wall. Tool holder 10 includes a main tubular pliant and drapable cloth panel which drapes over the upper rim of the bucket and extends downwardly essentially covering the inside surface of bucket 12. That same piece of cloth drapes over the outside surface of bucket 12, covering a major portion of that surface. The cloth drapes over the inside surface of the bucket as inside panel 22 which drops downwardly close to bottom 50 of bucket 12 terminating at lower end 48 where it is folded continues upwardly to form lower inner pockets 44. The same main body of cloth extends downwardly from section 20 of the cloth over the outside surface of bucket 12 as outside section 24, terminating proximate the lower edge of the outside surface of bucket 12. Pockets 26 are sewn onto inside panel 22 to hold tools 27. Pockets 28 and 31 are formed on outside section 24.

Baumgartner's invention relates generally to lady's bags wherein there are provided a series of different pockets each of which is adaptable for a particular use. As shown in Figures 1 and 4, on the upper side of the top panel 11 of a lady's overarm carrying bag 10, a generally rectangular panel 23 is secured to panel 11 by means of stitching to form a pocket 25 having an access opening 26 having an elastic band 27 along the edge thereof to gather the edge 26 and thus retain objects placed into the pocket 25. As shown in Figure 6, the opposite sides of the panel 23 may be accordion pleated as shown at 28 to allow expansion to receive objects there within. The pocket 25 serves to contain a pad and pencil, a pen, cleansing tissues, gloves or the like.

Yoo's invention relates generally to sports accessory bags having multiple compartments for separate storage of athletic shoes and accessories, including at least one expandable compartment, and a reinforced compartment for carrying a racket. As shown in Figure 6, the sports accessory bag includes a plurality of personal hygiene compartments 28 designed to hold items such as hair spray, deodorant, powders, perfumes, shampoo, conditioner, etc. Yoo teaches (column 4, line 68, to column 5, line 3) that these compartments 28 may be formed, for example, as pockets of fabric with an elastic piece sewn in an opening edge to hold an item in the pocket opening.

In the rejections under 35 U.S.C. § 103 before us in this appeal (final rejection, pp. 2-8), the examiner (1) ascertained that Lindsay did not teach a pocket including a resilient opening, the size of the opening being variable depending upon the extent to which the resilient opening is extended; and (2) concluded that it would have been obvious in view of the teachings of Baumgartner alone or the teachings of both Baumgartner and Yoo to have provided elastic bands in the openings of Lindsay's pockets 26 and 28 to resiliently retain items in the pockets 26 and 28.

The appellant argues that the applied prior art does not suggest the claimed subject matter. We agree. In that regard, while both Baumgartner and Yoo teach the use of a resilient opening pocket, we fail to discern any teaching, suggestion or motivation therein which would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified Lindsay's tool holder to include a resilient opening pocket. In our view, the only suggestion for modifying Lindsay in the manner proposed by the examiner in the rejections before us in this appeal to arrive at the claimed invention stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir.

1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claims 1 to 31.

REMAND

We remand the application to the examiner for further consideration of the patentability of claims 1 to 31. Specifically, the examiner should determine whether or not claims 1 to 31 are patentable under 35 U.S.C. § 103 over the teachings of Lindsay combined with the teachings of U.S. Patent No. 5,209,384¹ to Anderson² taking into account the evidence of non-obviousness of record in the application.³ The teachings of Lindsay have been set forth above. Anderson's invention relates to a portable kit which enables an individual to transport a complete set of hand tools with relative ease and convenience. More particularly, Anderson's invention relates to a portable tool kit with a plurality of vertically oriented tool storage compartments, each compartment being configured with tool holders of varying configurations so that once tools are placed in their appropriate holder they will remain in place until they are needed by the operator. Each tool storage compartment has a separate sealing device. Anderson teaches (column 5, lines 59-64) that

¹ Issued May 11, 1993.

² Copy attached.

³ See the Declarations of Gary Cohen and Andrea F. Bell filed on January 7, 2002 and the declaration of George Millican, Jr. filed on March 23, 2001.

Another configuration for retaining hand tools in place in tool holders is shown in FIG. 4 where across the tops of pockets 58 there is a line or band of elastic 60 which requires some force to insert the hand tool into the pocket and thereafter holds the hand tool in place until a similar force is used to withdraw the hand tool.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 31 under 35 U.S.C. § 103 is reversed. In addition, we have remanded the application to the examiner for further consideration.

This application, by virtue of its "special" status, requires immediate action, see
MPEP § 708.01.

REVERSED and REMANDED



NEAL E. ABRAMS
Administrative Patent Judge

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BOARD OF PATENT
APPEALS
AND
INTERFERENCES



JEFFREY V. NASE
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